

rejection of the above claims is found in the applicants' response of May 22, 1995 in patent application SN 08/709,112 (now USP 5,761,621). In that response, the Examiner urges that the amendments to claim 1 of the '112 application (which is drawn to a radio frequency management system for reallocation of radio spectrum) of:

- "a plurality of wireless communication networks using differing radio frequency modulation protocols and differing radio frequencies"
- "a first wireless communication network operating using a first radio frequency spectrum allocated to said first wireless communication network and using a first modulation protocol"
- "a second wireless communication network operating using a second radio frequency spectrum allocated to said second wireless communication network and different from said first radio frequency spectrum and using a second modulation protocol"

constitutes a surrender of broader subject matter from the originally filed claim 1 where the above features do not appear. However, the applicants traverse this finding of impermissible "recapture" under In re Clement for two reasons.

Initially, the applicants would point out that In re Clement teaches that recapture of surrendered material occurs when the patentees make amendments to the patented claims which broaden the scope of the patented claims, and when that subject matter of the broadening is directly related to subject matter which was surrendered (by amendment) during the initial examination in order to obtain a patent. In Clement the patentees presented, during original examination, amendments which continually narrowed the one and only independent claim, drawn to a method of processing pulp to remove "stickees" and inks, in order to avoid the prior art applied by the examiner. In contrast, in the instant reissue application the newly added claims 25-46 do not amend the patented claimed invention, i.e.,

claims 1-22 (drawn to a radio frequency management system for reallocation of radio spectrum), but instead presents claims to **other embodiments** of the disclosed radio frequency management system which are different from those of patented claims 1-22. Note, patent claims 23 and 24 (discussed more fully below) are drawn to a “radio frequency management system for providing information useful in the selecting among a plurality of wireless communications networks having different and variable operating characteristics...” (emphasis added) which is yet another embodiment of the disclosed radio frequency management system and is different from that the embodiment of independent claim 1 and newly added claims 25-46. The applicants assert that presentation, in one or multiple reissue applications, of additional embodiments of a disclosed and patented invention (that is, the filing continuing (reissue) applications for parts of the initial patent which **are not for separate and distinct parts of the thing patented**) is specifically permitted by In re Graff, 111 F.3d 874, 42 USPQ2nd 1471, see MPEP 1451- DIVISION REISSUE APPLICATIONS.

To illustrate that the newly presented claims 25-46 are drawn to additional embodiments of the disclosed invention, the Examiner is requested to compare the patented claims 1, 13, and 23 with the instant independent claims 25, 29, 33, 38 and 42-46. Such a comparison will reveal that the Examiner’s reliance on In re Clement and rejection of claims 25-46 under 35 U.S.C. 251 does not meet the fact pattern or requirements of In re Clement to support a finding of improper recapture of patented subject matter by the applicants. In particular, this comparison will demonstrate that applicants did not, in fact, surrender the broadly defined subject matter described in the original claim 1, filed December 15, 1993.

Turning now to the comparison of patented claims 1, 13, and 23 to the newly added independent claims 25, 29, and 33 it must be pointed out that “recapture” under Clement does not exist where the inventive concept of the newly submitted claims was not previously claimed, see the requirements for “broadening” in MPEP 1412.03. Specifically, each of the

claims 25, 29, and 33 is drawn to a “method” of operating a cellular radio network by assigning a different portion of the frequency band allocated (available) to the network as a control channel to each of two or more independent radio communications systems operating in a common geographic area, and then allowing the remainder of the allocated frequency band of the network to be shared by the two or more independent radio communication systems. The method claimed in the instant claims 25, 29, and 33 is an inventive concept that was disclosed (column 2, lines 36-42; column 3, lines 25-42; column 16, lines 28-60; column 18, lines 42-49) but not claimed in application SN 08/709,112 (USP 5,761,621), and which is a different embodiment from the “Radio frequency management system” (apparatus) of claims 1-12 and 23-24 and different from the “method for reallocation of radio frequency spectrum” of claims 13-22 in ‘621 patent that were amended prior to issue on May 22, 1995 in the manner pointed out by the Examiner in the most recent Office action of April 11, 2001. The radio frequency management system (apparatus) of claims 1-12 and 23-24 of the ‘621 patent specifically require “means” whose functions are nowhere found in the method claims 25, 29, and 33 of the instant application. In particular, the method claims 25, 29, and 33 do not contain any “means” for 1) detecting a network’s capacity, 2) reallocating the frequency of one network to another network approaching full capacity, or 3) changing the network frequency settings of a one or more portable radio devices. Additionally, the “method for reallocation of radio frequency spectrum” of claims 13-22 requires the specific combination of steps of “generating”, “reassigning”, and “causing” which are nowhere found in claims 25, 29, and 33 of the instant application. Therefore, since the application SN 08/709,112 (USP 5,761,621) never presented claims to a method of sharing radio frequency as set forth in claims 25, 29 and 33, the rejection of claims 25-37 under 35 U.S.C. 251 under the doctrine of “recapture” according to MPEP 1412.02 is improper. Further, the presentation of claims 25-37 (which are for parts of the initial patent which **are not for separate and distinct parts of**

the thing patented) is clearly sanctioned under In re Graff. As a final note, it is further pointed out that claims 25-37 are permitted under the “broadening” requirements of 35 USC 251 since the instant reissue application was filed prior to the two-year bar in the statute as set forth in MPEP 1412.03.

With regard to the instant claims 38-41, a similar argument to that above traversing the rejection under the “recapture” provision of 35 U.S.C. 251 is appropriate. Particularly, each of the instant claims 38-41 is drawn to a “cellular communications network” (apparatus) which, like the instant method claims 25, 29, and 33, is a different inventive concept (disclosed but not claimed in application SN 08/709,112 (USP 5,761,621) from the apparatus claims 1-12 of the application SN 08/709,112 (USP 5,761,621). That is, the apparatus claims 38-41 do not contain any “means” for 1) detecting a network’s frequency capacity, 2) reallocating the frequency of one network to another network approaching full capacity, or 3) changing the network frequency settings of a one or more portable radio devices. In contrast, the instant claim 38-41 require the assignment of different (frequency band) control channels, to a plurality of radio communication systems of a cellular communication network, within the frequency band of the network, and then permitting the remainder of the frequency band (range) of the network to be shared by each radio communication system. These features are not set forth in either the apparatus claims 1-12 or the method claims 13-22 of original application SN 08/709,112 (USP 5,761,621). Therefore, since the inventive concept (embodiment) of claims 38-41 was never claimed (or examined) in the application SN 08/709,112 (USP 5,761,621), the claims 38-41 have been improperly rejected under 35 U.S.C. 251 relying on the doctrine of “recapture” based upon In re Clement.

Claims 42-46, upon making a comparison with patented claims 1, 13, and 23, similarly avoid any proper application of “recapture” under 35 U.S.C. 251. Specifically, claims 42-46 are directed to a wireless communication system including features not included

in either claim 1, 13 or 23 as issued in the subject '621 patent. As one example, claim 42 sets forth a "frequency allocator" by allowing portions of the radio spectrum, otherwise available to another wireless service network, to be used by the wireless service network experiencing increased demand. This limitation is not part of patented claim 23 and thus precludes application of the recapture rule to claim 42. Similarly, claim 43 describes a "frequency reallocator"; while claim 44 describes a memory for storing user defined criteria for selecting a wireless service each of which is not included in the patented claim 23. Finally, claims 45 and 46 also set forth a "frequency reallocator" that is not included in claim 23.

The applicants' second reason for traversal of the rejection of claims 25-46 under 35 U.S.C. 251 is that the patentees, in the amendment of May 22, 1995 (in the SN 08/709,112 application) amended the features of claim 1 as pointed out by the examiner, but the applicants also added new claims 23 and 24, which did not include the limitations noted by the examiner as constituting a surrender of subject matter and which are drawn to a "radio frequency management system for providing information useful in the selecting among a plurality of wireless communications networks having different and variable operating characteristics..." (emphasis added) These later claims 23 and 24, drawn to an embodiment of the disclosed invention for a "radio frequency management system", are a different embodiment from that of claims 1-22 and do not contain any of the above limitations referred to by the Examiner as constituting a surrender of subject matter. The newly added claims 23 and 24 were in fact intentionally constructed to emphasize another (not separate and distinct) embodiment of the disclosed "radio frequency management system" while maintaining the broader language originally presented claim 1, and specifically left out the limitations of amended claim 1 referred to by the Examiner as constituting a surrender of subject matter. Therefore, for the reasons advanced above, none of the independent claims 25, 29, 33, 38,

and 42-46 (and none of the claims dependent thereon) are properly rejected under the 35 U.S.C. 251 "recapture" rule.

Finally, the Examiner's rejection of claim 44 under 35 U.S.C. 103(a) as being unpatentable over Zicker, in view Andrews is respectfully traversed. In particular, the Zicker reference, while teaching hardware similar to that claimed, in actuality teaches and suggests a wireless communication network system which is the exact opposite of that instantly claimed. Specifically, Zicker (column 2, lines 60-68; column 3, lines 1-25) sets forth a wireless communication network system in which **the user is not regarded as qualified to make instantaneous pricing decisions while "roaming"**, and, therefore, the wireless communication network system **takes that network access decision-making process out of the users hands**. Zicker then sends to each subscriber's cellular phone the necessary data (including available system telephone identifiers, e.g., phone numbers) which are determined at a central provider location. This process is carried out automatically, with no user input, by sending call availability information "automatically" to each cellular phone on the provider's network (column 16, lines 47-53). The Zicker system does not have the claimed feature of "memory for storing a user criteria for selecting a wireless service" since the patentee teaches that a roaming customer **"is not prepared to make, or interested in making, a purchasing decision with response to telecommunication, services every time he or she is roaming. While roaming, a customer is unlikely to know the rates charged by the competing foreign cellular systems. Moreover the rate structures may be too complicated..."** (emphasis added) In the Zicker wireless communication network system the user has no ability to enter his or her own criteria for selecting an available network. The Andrews reference, by only teaching providing cellular phones with the ability to access multiple networks operating at multiple frequencies by having frequency and protocol agile circuitry, does not remedy the deficiency of Zirker noted above. Nor has the Examiner

provided any suggestion or motivation as why one of ordinary skill in the art would modify the provider controlled wireless communication network system of Zirker with a system in which the user controls the selection of an available network as is instantly claimed.

For these reasons, claim 25-46 are in condition for allowance. However, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Upon the Examiner finding that claims 1-46 are in condition for allowance, the applicants request that consideration begin of the Request for Declaration of Interference 37 CFR 1.607 filed on September 8, 1999.

Respectfully submitted,

Date:

May 29, 2001

Charles M. Leedom

Charles M. Leedom
Registration No. 27,477

NIXON PEABODY LLP
8180 Greensboro Drive, Suite 800
McLean, VA 22102
Telephone: (703) 790-9110
Fax: (703) 883-0370

CML:JWM